UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,698	10/17/2000	Guy Nathan	871-95	1505

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EXAMINER
NGUYEN, DAT

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/688,698	NATHAN ET AL.
	Examiner	**Art Unit**	
	Dat T. Nguyen	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12 and 15-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *12 and 15-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the amendment filed June 27, 2005 in which applicant

amends claims 12 and 19 and responds to claim rejections. Claims 12 and 15-19 are pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to
> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

3.   Claims 12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune and further

in view of Tom & Liz's Name That Tune.

Martin et al. discloses a method and apparatus for managing a plurality of computer

jukeboxes at different locations from a remote central station. The remote central station

maintains a host computer having a master library of songs stored in a bulk storage unit and

each "jukebox" maintains a subset song library of the master library of songs. Each jukebox

is updated with new songs and menus by simply downloading the data via a transmission

link. Furthermore, in one embodiment, the computer jukebox is associated with an

electronic game. Martin et al. additionally discloses:

Regarding Claims 12 and 19:

- a remote server (central management system (11)) and at least one terminal

    (jukebox #1..jukebox #N (13)) operable to communicate with the server over a

communications network, wherein the terminal (jukebox) includes an audio

system (**127**, **129**, and **131**) for playing in connection with a game (electronic

game) at least a portion of a musical recording (Abstract, Figures 1, 4A, 4B, 5,

Column 1, line 66-Column 2, line 51, and Column 3, line 15-Column 4, line 40,

and Column 9, lines 38-42);

- the terminal is a jukebox system that includes a storage device (**93**) that stores a

  library of musical recordings (**91**) that can be played in full on the terminal for a

  fee (Figure 5), and further wherein the library of musical recordings can be

  updated with additional musical recordings through communication with the

  server, thereby defining a customized library of musical recordings on the

  jukebox system (Abstract, Figure 1, 4, 5, Column 1, line 66-Column 2, line 51,

  Column 3, line 15-Column 4, line 40, Column 4, lines 58-63, Column 5, lines 40-

  57, Column 6, lines 8-18, Column 6, lines 45-52, and Column 7, lines 39-57).

Martin et al. seems to lack explicitly disclosing:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple

  choice answers to the question, wherein the question relates to the portion of

  musical recording that has been played, a user interface that enables a user to

  select an answer from the displayed multiple choice answers, and a scorer for

  recording the answer selected by the user and determining if the answer

  corresponds to a correct answer; and

- further wherein the jukebox system is operable to dynamically select the musical

  recording for the game from the customized library of musical recordings and to

dynamically generate the question for the game based on the contents of the

customized library of musical recordings stored on the jukebox system.

Regarding Claim 15:

- the terminal sends information to the server regarding how the user

    performed during the game.

Johnny Rockets Name That Tune teaches of a Name that Tune game that is played

over a network, such as, the Internet. Johnny Rockets Name That Tune and Martin et al.

are analogous art because each are computerized game systems that are associated with

music played on jukeboxes. Johnny Rockets Name That Tune, however, seems to lack

explicitly disclosing playing a song for a fee.

Johnny Rockets Name That Tune teaches:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple

    choice answers to the question (questions 1-5), wherein the question relates to

    the portion of musical recording that has been played, a user interface (Web

    page and player personal computer mouse and keyboard) that enables a user to

    select an answer from the displayed multiple choice answers, and a scorer for

    recording the answer selected by the user and determining if the answer

    corresponds to a correct answer (How Did I Do?); and

- further wherein the jukebox system is operable to dynamically select the musical

    recording for the game from the customized library of musical recordings and to

    dynamically generate the question for the game based on the current contents of

    the customized library of musical recordings stored on the jukebox system.

<u>Merriam-Webster's Collegiate® Dictionary, Tenth Edition</u>, defines dynamically as marked by continuous and productive activity or change; or of random-access memory: requiring periodic refreshment of charge in order to retain data. The examiner submits any computer, including any computer storing the Johnny Rockets Name That Tune game, contains random-access memory that obtains periodic refreshment of charge in order to retain game data. Additionally, the examiner asserts the process of creating (programming, generating, configuring) the Johnny Rockets Name That Tune game and the actual playing of the Johnny Rockets Name That Tune game is a dynamic process. The music numbers 1 (Leader of the Pack), 2 (Great Balls of Fire), 3 (That'll be the Day), and 4 (The Wanderer) are dynamically displayed and played in a sequence in time as the game is played. The process of playing the game is a dynamic process, not a static one. Furthermore, regarding the current contents of the musical library, the Johnny Rockets Name That Tune game can only be played with the data stored in the memory at that point in time. Therefore, the contents in memory are the current contents of the musical library. Furthermore, Martin et al. discloses updating the musical recordings via communication with a server.

4.   Regarding Claims 15 and 19:

- the terminal sends information to the server regarding how the user performed during the game (How Did I Do?).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Johnny Rockets Name That Tune game in Martin et al. One would be motivated to combine Martin et al. with Johnny Rockets Name That Tune

because the Johnny Rockets Name That Tune game is entertaining and would provide an

additional source of profit for Martin's computer jukebox system when in the game mode.

5.   Regarding claims 12 and 19, Martin et al. also seems to lack explicitly disclosing:

        Updating of the customized libraries of musical recordings stored on the jukebox

system with musical recordings stored on the server for the needs of the game. Tom and

Liz's Name That Tune is a music trivia game that updates weekly (pp 1 of 10). The music

for the game must be the same for all systems on the network. Martin et al. also discloses

the ability of the central server to transmit songs to the jukeboxes as needed. Martin et al.

and Tom and Liz's Name That Tune are analogous art because both are computerized

games played over a network associated with music. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of invention to incorporate the weekly

updating of the song library with the jukebox networking system of Martin et al. One would

be motivated to combine Martin et al. with Tom and Liz's Name That Tune because it the

prospect of competing with other plays would raise user interest in the jukebox system.

6.   Regarding claims 16-18, Johnny Rockets Name That Tune teaches that as

discussed above regarding Claims 12, 15, and 19. Johnny Rockets Name That Tune seems

to lack explicitly disclosing a ranking system to rank player' performance.

        Tom & Liz's Name That Tune, like Johnny Rockets Name That Tune is a

computer/network-based name that tune game. Tom & Liz's Name That Tune shows:

        Regarding Claim 16:

    •   the server collects game performance information for a plurality of different users

        and ranks the users according to their performance (pp. 4 and 5 of 10).

Regarding Claim 17:

- the server is operable to send user-ranking information to the terminal, and the terminal is operable to display ranking information.

Regarding Claim 18:

- the system includes a plurality of said terminals (each player's personal computer having an Internet connection) at different locations (players live in a plurality of states), each of the terminals being operable to communicate with the server, and further wherein the server is operable to collect performance information on users who play the game at any of the terminals to send user ranking information to each of the terminals.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the player performance ranking system of Tom & Liz's Name That Tune game in Johnny Rocket's Name That Tune game and Martin et al. Providing a display of player rankings for games or game tournaments is notoriously well known to one of ordinary skill in the gaming art. Doing so motivates a game player to perform well and enables players to size up the competition.

Response to Arguments

Applicant's arguments filed June 27, 2005 have been fully considered but they are not persuasive.

Applicant alleges that the amended claims are patentably distinguished over the cited references in the requirement that the game module updates the customized library of the terminal as needed for the purposes of the game. Examiner respectfully disagrees and has addressed the amended claims above.

Applicant alleges that "Johnny Rockets Name That Tune" or "Tom and Liz's Name That Tune" games do not comprise a game module operable to control, for the needs of the game the updating of the customized libraries of musical recordings stored in a jukebox system with musical recordings stored on the server. Examiner agrees and has formulated a new rejection using Martin et al. in combination with Johnny Rockets Name That Tune or Tom and Liz's Name That Tune.

Applicant further states that there is no motivation to combine. Examiner respectfully disagrees; please see rejection above.

Applicant alleges that Johnny Rockets or Tom and Liz's Name That Tune are game systems associated with music played on a computer, which cannot be considered a jukebox. Martin et al. however, discloses that the present invention is "basically a computer having a sophisticated audio production capability, the computer storing digitized song data in a computer memory," (col. 2, lines 29-33).

Applicant challenges the obviousness of the Martin et al. and Tom and Liz's Name That Tune combination. Examiner maintains previous examiner's rejection. As it was discussed above, Martin et al. could be considered a network of linked computers. Therefore Martin et al. and Tom and Liz's Name That Tune are analogous art because they are both computer-networked systems capable of playing music and gaming applications.
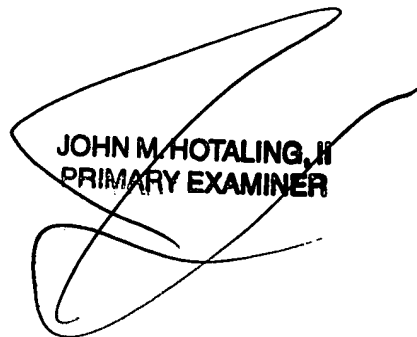
Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dat T. Nguyen whose telephone number is

5712722178. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John M. Hotaling can be reached on (571)272-4437. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dat Nguyen

JOHN M. HOTALING, II
PRIMARY EXAMINER